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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,045	12/27/2001	Thomas E. Jacobs	023720-0250	1658
26371	7590	11/19/2003	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			BAHTA, ABRAHAM	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 11/19/2003.

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,045

Applicant(s)

JACOBS, THOMAS E.

Examiner

Abraham Bahta

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-- Th MAILING DATE of this communication appears on the cov r sh t with th correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 35-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Applicant's election of Group I (claims 1-34) in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Claims 1-2, 4, 6 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by

Van Houten USP 6,517,168).

Van Houten teaches an article such as a wheel cover for a vehicle having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries (which may be interpreted as characteristic of different shapes) so that many different ornamental designs can be provided. See col. 5, lines 15-22.

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Concerning claim 2, the reference teaches the wheel cover may have apertures or openings. See col. 5, lines 15-22.

With respect to claim 4, the reference teaches the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 19-21.

Regarding claim 6, the reference teaches the pocket inserts may be fully inserted into the turbine pocket. Thus, the inserts interface with one another.

Regarding claim 10, the wheel cover is configured to be attached to a wheel of a vehicle. See col. 4-7.

Regarding claim 11, the reference teaches the wheel cover may be mechanically fastened to a wheel. See col. 5, lines 8-10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 7-9, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten '168.

Van Houten is discussed above.

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Regarding claim 3, Van Houten is silent regarding the color as recited in claim 3, the outline being correlated to a portion of a motor vehicle as recited in claim 5, the surface profile being a flat, concave or convex, the indicia provided to the elements or inserts as recited in claims 8-9; however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable and that the turbine pocket may take on any number of various geometries so that many different ornamental designs can be provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the interchangeable inserts of Van Houten with various designs, shapes, colors and profiles in order to decorate or accent a vehicle according to the users individual taste.

Regarding claim 12, the reference does not require the cover to be fastened to a vehicle grille; however, it would have been obvious to one of ordinary skill in the art to modify the cover of Van Houten, for example, by changing the size of the cover and attach it to a desired support including a vehicle grille so that the device may be displayed in front of the vehicle.

Regarding claim 13, Van Houten does not require permanently coupling the inserts to the wheel cover; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permanently couple the inserts to the wheel cover, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

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Concerning claim 14, the reference does not mention the device is a medallion; however, a medallion is a flat piece of metal stamped with a design or inscription, therefore the wheel cover of Van Houten may be interpreted as a medallion because the device comprises depressions or pockets having various geometries and ornamental designs. Further, it is within the judgment of the skilled artisan to select a fixed number of configurations depending on the openings or apertures formed on the base or wheel cover of Van Houten.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-17, 19, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by

Van Houten '168.

Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

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Regarding claim 16, Van Houten teaches the wheel cover is provided with opening or apertures. See col. 5, lines 15-22.

Concerning claim 17, the reference teaches the turbine pockets provided on the wheel cover receive inserts. See col. 5, lines 15-22.

Regarding claim 19, the reference teaches the pocket inserts may be fully inserted into the turbine pocket. Thus, the inserts interface with one another.

Regarding claim 23, the wheel cover is configured to be attached to a wheel of a vehicle. See col. 4-7.

Regarding claim 25, the reference teaches depressions may be provided to the wheel cover. See col. 5, lines 17-20.

Claim Rejections - 35 USC § 103

Claims 18, 20-22, 24, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten '168.

As discussed above, Van Houten teaches applicant's claimed invention except the specific outline as recited in claim 18, specific profile as recited in claim 20, indicia as recited in claims 21-22; however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable and that the turbine pocket may take on any number of various geometries so that many different ornamental designs can be provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the interchangeable inserts of Van

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Houten with various designs, shapes, colors and profiles in order to decorate or accent a vehicle according to the users individual taste.

Regarding claim 24, the reference does not require the cover to be fastened to a vehicle grille; however, it would have been obvious to one of ordinary skill in the art to modify the cover of Van Houten, for example, by changing the size of the cover and attach it to a desired support including a vehicle grille so that the device may be displayed in front of the vehicle.

Concerning claim 26, the reference does not mention the device is a medallion; however, a medallion is a flat piece of metal stamped with a design or inscription, therefore the wheel cover of Van Houten may be interpreted as a medallion because the device comprises depressions or pockets having various geometries and ornamental designs.

With respect to claim 27, Van Houten does not require permanently coupling the inserts to the wheel cover; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permanently couple the inserts to the wheel cover, since it has been held that forming in one piece an article which has formelrly been formed in two pieces and put together involves only routine skill in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 28-29, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Houten '168.

Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

Regarding claim 29, the reference teaches the wheel cover comprises a set of interchangeable inserts formed in a variety of ornamental design. See col. 5, lines 20-22.

With respect to claim 32, the reference teaches the number of pocket inserts correspond to the number of turbine pockets of the wheel cover and that various geometries of different ornamental designs can be provided. See col. 5, lines 20-22 and lines 37-39.

Concerning claim 34, the reference teaches the number of inserts are associated with the pocket turbine and that the inserts are fully inserted in the pockets.

The Examiner notes claims 28-34 are drawn to a product-by-process limitation; however, patentability of product-by-process claims are based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or

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obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 103

Claims 30, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten '168.

As discussed above, Van Houten teaches applicant's claimed invention except the surface profile which includes at least one of flat, concave and convex and color characteristic of a set of inserts as recited in claims 30, 31 and 33; however, since the reference teaches various design decorations may be provided to the inserts, it would have been obvious to one of ordinary skill in the art to profile the inserts with various decorative shapes or designs as an obvious matter of design choice.

Claim Rejections - 35 USC § 103

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockwood (USP 4,556,588) or Pierce (USP 6,434,873) in view of Van Houten '168.

Rockwood teaches an emblem made of two parts, a base and a capped inlay. The inlay is attached to the base member with a layer of an adhesive which is coated on the reverse side of foil member and which is the same as or similar to the adhesive layer. The reference teaches a rim may be provided around the base and the inlay may be sapped into place in the base member. See col. 3, lines 1-11.

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Pierce teaches a decorative display comprising a cavity wherein the an insert is placed into the space defined by the cavity. The insert may be an embossed paper, embossed cardboard, embossed plastic, stamped metal sheet, a hologram and combinations thereof.

Thus, Rockwood and Pierce teach an emblem or a decorative display wherein an decorative insert may be placed in the space defined by cavity.

Rockwood or Pierce do not require a plurality of inserts having different characteristics; however, Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the emblem of Rockwood or the display device of Pierce by providing more cavities or depressions and placing the desired number of interchangeable decorative inserts in the cavities or depressions as taught by Van Houten to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.

Regarding claims 2-9 , 16-22 and 29-34, since Van Houten inserts are decorative and

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interchangeable, it would be obvious to one of ordinary skill in the art to provide the desired color, outline, surface profile or indicia as a matter of obvious design choice.

Regarding claim 10 and 23, Rockwood teaches the emblem may be attached to a vehicle.

With respect to claim 11, Rockwood teaches the base member may have molded therewith tabs or projection which extend from the attachment surface for press-fitting into corresponding notches or holes on curved surface. See col. 2, lines 59-68.

With respect to claim 12 and 24, the references do require to attachment to a vehicle grille; however, since Rockwood teaches the emblem may be used to customize an automobile, it would be within the judgment of the skilled artisan to provide a suitable fastening means so that the emblem may fastened to a vehicle grille.

Concerning claim 14 and 26, Rockwood teaches the article is an emblem.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Response to Applicant's Arguments/Remarks

The applicant argues the limitation of claims 1, 10-11 are not anticipated by Van Houten '168 under 35 USC 102 (b). The Examiner disagrees. Van Houten teaches an article such as a wheel cover for a vehicle having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. The reference teaches the turbine pockets may take on any number of various (more than one) geometries so that many different ornaments designs can be provided. See col. 5, lines 15-22.

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Applicant further argues Van Houten does not disclose, teach, or suggest the “article” as recited in claims 2-14 and 16-27 and contends the suggestion to make the combination of “inserts” of Van Houten with “various design, shape, colors and profiles” has been taken from the Applicant’s own specification and that to transform the “wheel cover having interchangeable turbine pocket inserts” of Van Houten to the “article” recited in independent claim 1 would require still further modification. The Examiner disagrees. It is the Examiner position that Van Houten clearly teaches the number of pocket inserts correspond to the number of turbine pockets and that the pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-48.

With respect to claims 15, 23 and 25 the applicant argues the “set of articles” as recited in independent claim 15, as amended, is not identically disclosed by Van Houten. The Examiner disagrees. Van Houten clearly teaches the number of pocket insets correspond to the number of turbine pockets and that the pockets may take on any number of various (more than one) geometries so that many different ornamental designs can be provided. See col. 5, lines 15-48.

Regarding claims 28-29, 31-32 the applicant argues the article of claim 28 is not the same as or obvious from the product disclosed in Van Houten and the reference does not disclose an article with selected information associated with the article configuration. The Examiner disagrees. Van Houten teaches the turbine pockets may have openings that extend through the wheel cover, or alternatively can be closed depressions in one of the inboard or outboard surfaces

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of the wheel cover and that the turbine pockets may take on any number of various geometries so that many different ornament designs can be provided.

Concerning claims 30, 31 and 33 the applicant contends that the limitation of the claims is not obvious in view of Van Houten. The Examiner disagrees. Van Houten teaches applicant's claimed invention except the surface profile which includes at least one of flat, concave and convex and color characteristic of a set of elements; however, since the reference teaches various design decorations may be provided to the inserts, it would have been obvious to one of ordinary skill in the art to configure the inserts with various decorative shapes or design as an obvious design choice because the inserts are decorative.

The applicant argues the subject matter recited in claims 1-14 would not have been obvious over Van Houten in view of Rockwood or Pierce under 35 USC 103(a). The Examiner contends the Office action does not indicate claims 1-14 are rejected over Van Houten in view of Rockwood or Pierce. The Office action (page 8) states claims 1-34 are rejected over Rockwood or Pierce in view of Van Houten. The Examiner further contends Rockwood teaches an emblem made of two parts, a base and a capped inlay and Pierce teaches a decorative display comprising a cavity wherein an insert is placed into the space defined by the cavity. Both Rockwood and Pierce fail to suggest more than one cavity (a set of cavity) and more than one insert (a set of inserts or elements) may be employed to manufacture the emblem or the decorative display; however, Van Houten teaches a number of inserts may be positioned in a number of openings provided on a wheel cover in order to create many different ornament designs. It is the position of

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the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the emblem or the display device of the primary references by providing a number of cavities or openings and positioning the desired number of inserts in the openings in order to create many different designs as taught by Van Houten.

The applicant argues claims 28-34 would not have been obvious over Van Houten in view of Rockwood or Pierce. The Examiner contends the Office action does not indicate claims 28-34 are rejected over Van Houten in view of Rockwood or Pierce.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

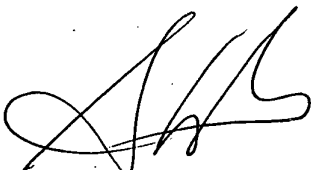
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Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412.

The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah, Jones, can be reached on (703) 308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



A. Bahta

11/04/03


DEBORAH JONES
SUPERVISORY PATENT EXAMINER